

Application No. 10/664,320

Reply to Office Action

REMARKS

The Office Action mailed February 23, 2006, and the references cited therein have been considered. All of the previously pending claims have been rejected. Applicant traverses the rejections of the claims over the prior art and has canceled certain ones of claims without prejudice to reintroduce the claims in this or a later filed application. Applicant has amended certain ones of the pending claims to recite "the manually operable input mechanism" in view of the Office Action's rejection under 35 U.S.C. Section 112, paragraph 2. For the reasons set forth herein below, Applicant requests favorable reconsideration of the Office Action's grounds for the previous rejection of the presently pending claims. Please charge any fee deficiencies to Deposit Account No. 12-1216.

Summary of the Prior Art-Based Rejections

1. Claims 1, 7-9, 14, 20-21, 26, 32, 37 and 80 are rejected as anticipated under 35 U.S.C. §102(e) in view of Oueslati et al. U.S. Pat. No. 6,806,865 (Oueslati).

2a. Claims 14, 16-17, 20, 26, and 28-29 are rejected as anticipated under 35 U.S.C. §102(e) in view of Hoggarth U.S. Pat. No. 6,654,004 (Hoggarth).

2b. Claim 75 is rejected as anticipated under 35 U.S.C. §102(e) in view of Langstraat U.S. App. Pub. US 2003/0076302.

3. Claim 1 and 3-4 are rejected as obvious under 35 U.S.C. §103(a) as being unpatentable over Hoggarth in view of Burnett U.S. Pat. No. 5,615,083 (Burnett).

4. Claim 2 is rejected as obvious under 35 U.S.C. §103(a) as being unpatentable over Hoggarth in view of Burnett and May U.S. Pat. No. 6,509, 890 (May '890).

5. Claims 5-6 are rejected as obvious under 35 U.S.C. §103(a) as being unpatentable over Hoggarth in view of Burnett and Fleck et al. U.S. Pat. No. 6,259,438 (Fleck).

6. Claims 10-11 are rejected as obvious under 35 U.S.C. §103(a) as being unpatentable over Hoggarth in view of Burnett and Maeda et al. JP 05/181,582 (Maeda).

7. Claim 12 is rejected as obvious under 35 U.S.C. §103(a) as being unpatentable over Hoggarth in view of Burnett and Miyashita et al. U.S. Pat. No. 6,909,906 (Miyashita).

8. Claim 13 is rejected as obvious under 35 U.S.C. §103(a) as being unpatentable over Oueslati in view of Langstraat U.S. App. Pub. US 2003/0076302 (Langstraat) filed Oct. 2001.

9. Claims 15 and 27 are rejected as obvious under 35 U.S.C. §103(a) as being unpatentable over Hoggarth in view of May '890.

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10. Claims 18-19 and 30-31 are rejected as obvious under 35 U.S.C. §103(a) as being unpatentable over Hoggarth in view of Burnett and Fleck.

11. Claims 22-23, 33-34, 47, 49-50, 57, 59-60, 81, 86-89 and 93-95 are rejected as obvious under 35 U.S.C. §103(a) as being unpatentable over Hoggarth in view of Maeda.

12. Claims 24, 35, 66 and 68-69 are rejected as obvious under 35 U.S.C. §103(a) as being unpatentable over Hoggarth in view of Miyashita.

13. Claims 25 and 36 are as obvious under 35 U.S.C. §103(a) as being unpatentable over Hoggarth in view of Langstraat.

14. Claims 37 and 39-40 are as obvious under 35 U.S.C. §103(a) as being unpatentable over Hoggarth in view of Oueslati.

15. Claim 38 is rejected as obvious under 35 U.S.C. §103(a) as being unpatentable over Hoggarth in view Oueslati and May '890.

16. Claims 41-42 are rejected as obvious under 35 U.S.C. §103(a) as being unpatentable over Hoggarth in view of Oueslati and Fleck.

17. Claims 43-44 are rejected as obvious under 35 U.S.C. §103(a) as being unpatentable over Hoggarth in view of Oueslati and Maeda.

18. Claim 45 is rejected as obvious under 35 U.S.C. §103(a) as being unpatentable over Hoggarth in view of Oueslati and Miyashita.

19. Claim 46 is rejected as obvious under 35 U.S.C. §103(a) as being unpatentable over Hoggarth in view of Oueslati and Langstraat.

20. Claim 48, 58, and 90-91 are rejected as obvious under 35 U.S.C. §103(a) as being unpatentable over Hoggarth in view of Maeda and May '890.

21. Claims 51-52 and 61-62 are rejected as obvious under 35 U.S.C. §103(a) as being unpatentable over Hoggarth in view of Maeda and Fleck.

22. Claims 54, 63 and 82-84 are rejected as obvious under 35 U.S.C. §103(a) as being unpatentable over Hoggarth in view of Maeda and Miyashita.

23. Claims 55, 64 and 85 are rejected as obvious under 35 U.S.C. §103(a) as being unpatentable over Hoggarth in view of Maeda and Langstraat.

24. Claims 56 and 65 are rejected as obvious under 35 U.S.C. §103(a) as being unpatentable over Hoggarth in view of Maeda and May U.S. Pat. No. 6,271,834 (May '834).

25. Claim 67 is rejected as obvious under 35 U.S.C. §103(a) as being unpatentable over Hoggarth in view of Miyashita and May '890.

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26. Claims 70-71 are rejected as obvious under 35 U.S.C. §103(a) as being unpatentable over Hoggarth in view of Miyashita and Fleck.

27. Claim 73 is rejected as obvious under 35 U.S.C. §103(a) as being unpatentable over Hoggarth in view of Miyashita and Langstraat.

28. Claim 74 is rejected as obvious under 35 U.S.C. §103(a) as being unpatentable over Hoggarth in view of Miyashita and May '834.

29. Claims 76-77 are rejected as obvious under 35 U.S.C. §103(a) as being unpatentable over Langstraat in view of Hoggarth.

30. Claims 78-79 are rejected as obvious under 35 U.S.C. §103(a) as being unpatentable over Langstraat in view of Hoggarth and Fleck.

31. Claim 95 is rejected as obvious under 35 U.S.C. §103(a) as being unpatentable over Langstraat in view of Hoggarth and May '890.

Applicant has canceled with traverse and without prejudice to resubmit at a later time, claims 3, 5, 6, 14-46, 52, 53, 62, 71, 75-80 and 92. Claim 1 has been amended to remove certain limitations and add the elements of claims 3 and 5. Applicant has also canceled claims directed to a touch screen. Applicant traverses the grounds for each and every rejection of the remaining pending claims for at least the reasons set forth herein below. Applicant addresses the rejections in detail herein below.

Applicant's Remarks Addressing The Prior Art-Based Claim Rejections of Pending Claims

Applicant has amended claim 1 to include elements recited in previously pending, now canceled, claims 3 and 5. Therefore, Applicant's remarks are directed to the Office Action's grounds for rejecting claim 5. In that regard, Applicant traverses the rejection of claim 5 as obvious under 35 U.S.C. §103(a) as being unpatentable over Hoggarth in view of Burnett and Fleck et al. U.S. Pat. No. 6,259,438 (Fleck). Fleck does indeed disclose a wheel. However, the wheel is not part of an input mechanism that is *attached to the base of an electronic device* as recited in claim 1 (amended to include the elements of claims 3 and 5). In fact, the device disclosed in Fleck is an electronic brush that must be free of any attachment to the base to facilitate its intended use – to create brush strokes of varying widths on a graphical display. Attaching the Fleck device to a base would destroy its functionality. Furthermore, rather than provide signals for cursor control, the wheel disclosed in Fleck controls a selected characteristic

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(e.g., width, shading, color) of brush stroke created by the drawing device. For at least these reasons, the teachings of Fleck cannot be applied to the combination of Hoggarth and Burnett to render the presently pending claim 1 (previously claim 5).

Applicant traverses the rejections of each of the presently pending claims that depend from amended claim 1 for at least the reasons provided in overcoming the rejection of claim 1.

Applicant traverses the rejection of independent claims 47, 57, 81, and 93 as obvious over Hoggarth in view of Maeda. Each of these independent claims includes a cursor control member including a memory that is accessible via a port when the cursor control member is connected to the port. The Office Action concedes that Hoggarth does not disclose a memory being included in the cursor control member and transfer of content from the memory to a processing unit via a port in the base. Maeda discloses placing memory in a thin device *shaped* like a pen or pencil. The stated purpose of Maeda's device is to transfer data between computers without a communications link. Maeda is essentially a "thumb drive". Nowhere does Maeda even remotely disclose that the device containing the memory is a *cursor control member*.

There is no suggestion to incorporate the memory storage capabilities of Maeda's devices into Hoggarth's cursor control device. There is no suggestion in Hoggarth of a need to incorporate memory into the disclosed cursor control device. Similarly, Maeda's memory transfer device accomplishes its stated purpose without any need for cursor control. Each of the distinct devices disclosed in Hoggarth and Maeda is fully functional to carry out specified desired functionality. Neither Hoggarth nor Maeda discloses a need that would be met by their combination. The Office Action has not identified any motivation/suggestion in either Hoggarth or Maeda for making Applicant's recited combination. In the event that the rejection of claims 47, 57, 81 and 93 is not withdrawn, Applicant requests identification of the asserted disclosure of a "cursor control member" in Maeda (see, pp. 21-22 of the Office Action) as well as the presumed suggestion to combine Maeda's memory capabilities with Hoggarth's cursor control device.

Applicant traverses each of the claims depending from claims 47, 57, 81 and 93 for at least the reasons set forth above in association with the Applicant's traversal of those claims.

Applicant traverses the rejection of amended independent claim 66. Claim 66, as amended, recites an *elongate slender* cursor control member including the recited *power supply*. In contrast, the cited Miyashita reference discloses a block-shaped mouse device that includes a battery. The Miyashita patent's battery appears to be the primary power source for the device. As

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such, it is an integral part of the device and size is really not an issue. In contrast, Applicant's recited slender cursor control device is intended to merely operate as a backup power source. The slender shape allows for easy storage of the cursor control member when not in use. On the other hand, the device disclosed in Miyashita occupies roughly half of the volume taken up by the device for which it supplies power. For at least this reason Applicant traverses the rejection of claim 66 and each of the claims depending from claim 66.

Conclusion

Applicant respectfully submits that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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